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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,626	01/11/2002	Olaf Gaertner		8106

7590 06/19/2003

Diller Ramik & Wight  
7345 McWhorter Place  
Merrion Square Suite 101  
Annandale, VA 22003

EXAMINER
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STEPHENSON, DANIEL P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/030,626

Applicant(s)

GAERTNER ET AL.

Examiner

Daniel P Stephenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 18-20, 24, 25, 27-29 and 32 is/are rejected.
- 7) ☒ Claim(s) 12, 14-17, 19, 21-23, 26, 30, 31 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references cited in the Search Report completed 10/27/2000 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.
2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

3. The disclosure is objected to because of the following informalities:  
  
On page 8, paragraph 8, line 2 the term "2" should be changed to "11".  
  
On page 10, paragraph 3, line 2 the term "3" should be changed to "43"  
  
On page 11, paragraph 3, line 12 the term "tightyl" should be changed to "tightly"  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11, 24, 25, 27, 29 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 11 recites the limitation "free end side" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 24 recites the limitation "free end side" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 25 recites the limitation "protective sleeve" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 27 recites the limitation "protective sleeve" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4-11, 13, 18, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. '789 in view of the Japanese patent to Moriki et al. Murray et al. '789 discloses a construction machine that uses a milling drum. The roller consists of an internal, rotating roller (122) and a milling sleeve (140) with cutters on its outer surface. The sleeve is connected to the internal roller by fastening components (138) on its inner surface. The internal roller is driven by a drive device that is connected to a transmission unit (126) through

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the use of a drive rod (102). The milling sleeve is mounted in a rotationally fixed manner through the use of the fastening components at the end of the unit and is radially supporting units on the other end consisting of a support ring (152) and shoulders (151). The sleeve's fastening components project radially from the inside of the sleeve. The sleeve is arranged at a radial distance from the rotating roller and projects from it axially. The transmission unit is integrated into the rotating roller. The sleeve is supported in at least two axially spaced positions along the rotating roller. The supporting units (152) are radially integral to the sleeve. The support ring (152) is divided at the midway point when the sleeve is separated. The transmission unit is arranged at the end of the rotating roller opposite from the drive unit. Murray et al. '789 does not explicitly disclose that the sleeve is a one piece sleeve. The Japanese patent to Moriki et al. discloses a milling drum that is composed of one piece. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the one-piece drum of the Japanese patent to Moriki et al. on the apparatus of Murray et al. '789. This would be done so that there were fewer pieces and less chance of a malfunction.

12. Claims 3 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. '789 in view of the Japanese patent to Moriki et al. Murray et al. '789 in view of the Japanese patent to Moriki et al. shows all the limitations of the claimed invention, except, neither Murray et al. '789 nor the Japanese patent to Moriki et al. disclose that the transmission element for the rotating roller is located at the drive side of the milling drum, nor do they disclose that the sleeve is attached only to the rotating roller. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the transmission element on the other side of the rotating roller and make the attachment of the sleeve only on the rotating rollers parts.

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This would be done since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

***Allowable Subject Matter***

13. Claims 12, 14-17, 19, 21-23, 26, 30, 31 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 24, 25, 27, 29 and 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

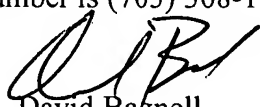
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The German patent '947 to Jacobs, Haehn et al. and Bjorkman et al all show similar elements to those of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.



David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

DPS *DPS*  
June 12, 2003